Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte ALFONSO M. MISURACA

_____

Appeal No. 1999-2081
Application 08/786,228

_____

HEARD: FEBRUARY 6, 2002

_____

Before PAK, LIEBERMAN, and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claims 1-9 and 11.

Claim 1 is representative of the subject matter on appeal and reads as follows:

1. An assembly for mixing a polymer with water and activating the polymer, comprising:

a mixing chamber having a first inlet, a second inlet and an outlet orifice having a peripheral seat at its distal end, wherein said seat has a cross-section shaped as a right angled corner;

means for introducing a flow of water to said first inlet;

means for introducing a flow of water to said first inlet;

means for introducing a flow of said polymer to said second inlet;

a plug disposed outside said mixing chamber and shaped to seal said outlet orifice along said seat; and

means for yieldable biasing said plug against said outlet orifice peripheral seat;

whereby the flow of the mixed water and polymer exerts a force against said plug which causes said plug to move away from said outlet orifice seat against the force exerted by said biasing means so as to provide a gap between said plug and said outlet orifice seat which results in the activation by shearing of polymer passing through said gap.

In support of the rejection, the examiner relies on the

following prior art:

Brooks	1,925,787	Sept. 5, 1933
Lavine	2,124,580	July 26, 1938
Robinson	2,817,500	Dec. 24, 1957
Hendrikz	4,199,267	Apr. 22, 1980
Brazelton et al. (Brazelton)	5,135,968	Aug. 4, 1992

Claims 1-9 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combined disclosures of Brazelton taken with Robinson, Hendrikz, Brooks, and Lavine.

We have carefully reviewed the claims, specification and applied prior art, including all the arguments advanced by both the examiner and appellants in support of their respective positions. This review leads us to conclude that the examiner's § 103 rejection is not well-founded. Accordingly, we reverse the examiner's § 103 rejection for essentially those reasons set forth in the brief. We add the following for emphasizes and completeness.

First, we note that the examiner bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Appellant acknowledges that the secondary reference of Lavine teaches a spring loaded ball valve in a emulsification device. (Brief, page 7). However, appellant correctly points out that Lavine and the other applied references lack the recitation of a right angle corner seat to define an orifice. (Brief, page 8). This is made evident by a comparison of appellant's figure with Figure 8 of Lavine. Specifically, appellant's seat 30 is different from Lavine's cup shape member 39 having centrally disposed opening 40 adaptive to be closed by a ball valve member 41. We note that the examiner does not address this difference in his answer. (Answer, pages 3-5).

Assuming, *arguendo*, that appellant's claimed invention is a combination of old elements, we note that the fact that elements are old in the art not does not

necessarily mean the invention is obvious, nor is the use of hindsight permitted. Graham v. John Deere Co., 383 U.S. 1, 37, 148 USPQ 459, 474 (1966). As correctly pointed out by appellant on pages 7 and 8 of the brief, the combination of references lacks the requirement that some teaching, suggestion or incentive derived from the prior art supports the combination. ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). In this context, we note that the examiner has not explained why the references themselves would have led one of ordinary skill in the art to combine their teachings as proposed by the examiner. This is a further deficiency in the examiner's presentation. See In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). For example, the examiner has not provided an explanation of why one of ordinary skill in the art would have been motivated to substitute the ball assembly of Lavine for apparatus 22 of Brazelton, especially in view of the fact that apparatus 22 of Brazelton is concerned with high shear mixing, whereas the ball valve assembly disclosed in Lavine concerns emulsification and blending of liquids.

Accordingly, we find that the examiner has not met his burden of setting forth a *prima facie* case of obviousness.

In view of the foregoing, the decision of the examiner is reversed.

REVERSED

Chung K. Pak)
Administrative Patent Judge)
)
)
) BOARD OF
PATENT Paul Lieberman)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
Beverly A. Pawlikowski)
Administrative Patent Judge)

BAP/cam

David L. Davis
Plaza 9 900 Route 9
Woodbridge, NJ 07095